

**DECISION ON PETITION
ROUTING SLIP
TC 1600**

Application No.: 9/578,194 Art Unit: 1635 Date 3/19/3

For Director's Secretary:

☐ **Granted** ☒ **Denied** ☐ **Dismissed**

☒ Decision to be reviewed and signed by Director Dale

☒ Mail Decision

☐ Enter Change of Address in PALM

☒ Enter paper Nos. _____ and the decision in PALM

☐ Other _____

For Tech Support Staff and/or LIE:

☐ Process and enter paper Nos. _____

☐ Charge _____ fee to D.A. No. _____

☐ Other _____

☒ Forward file to Examiner

Questions should be directed to:

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UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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DANA REWOLDT
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In re Application of Marcelo Dornelas et al. :
Serial No.: 09 578,194 :
Filed: May 24, 2000 : PETITION DECISION
Attorney Docket No.: 026-1 :

This is in response to applicants' petition, filed December 9, 2002 under 37 CFR 1.144, requesting withdrawal of the restriction requirement set forth by the examiner.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111 on May 24, 2000. The application, as filed, contained claims 1-24. On August 13, 2001, the examiner mailed an Office action including a restriction requirement dividing the claims into 2 groups, and requiring a further election of a single species of plant and of a single nucleic acid sequence for examination. In the response filed June 11, 2002, applicants elected group II, and further elected *Arabidopsis* as the plant species and the dzeta ASK gene as the nucleic acid sequence to be examined, with traverse. Applicants traversed the restriction requirement on the same grounds presented in the petition, discussed below. On August 30, 2002 the examiner mailed a first Office action on the merits wherein the restriction requirement was made final.

DISCUSSION

Applicants have not traversed the restriction between groups I and II. The traversal concerns the further election of species within the elected group. Applicants appear not to understand that these are elections of species, not restriction, and that additional species will be examined should the elected species prove to be allowable. Nevertheless, applicants' arguments are addressed below.

Applicants argue that the examiner has not shown that the inventions are independent or distinct, or that it would be a serious burden to search all of the claimed species. This argument is not persuasive because these are the criteria used for determining whether restriction is proper, not election of species.

Applicants argue that all of the recited nucleotide sequences should be searched, citing MPEP 803.04. This argument is not persuasive for two reasons. First, MPEP 803.04 states that, in

certain cases, *up to* 10 sequences may be searched. This does not require the examiner to search 10 sequences. Second, the claims in the instant application are clearly dissimilar to those in the examples found in MPEP 803.04, and therefore the partial waiver of 37 CFR 1.141 does not apply in this case.

Applicants argue that the different plant species recited in the claims do not have mutually exclusive characteristics. This argument is not persuasive because, again, the cited section of the MPEP refers to restriction practice, not election of species. As stated in the original restriction requirement, "Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case." Absent any such evidence or admission, the examiner's position is not improper. Note that in the petition, applicants state, "The applicant is not suggesting...that the species are not patentably distinct" (p. 3, line 5).

DECISION

Applicants' petition is **DENIED** for the reasons set forth above.

The time period for response continues to run from the mailing date of the final rejection.

Any request for reconsideration or review of this decision must be made by a renewed petition and must be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely.

Should there be any questions with regard to this letter please contact Bruce Campbell by letter addressed to the Director, Technology Center 1600, Washington, DC 20231, or by telephone at (703) 308-4205 or by facsimile transmission at (703) 746-5006.

John Doll
Director, Technology Center 1600

John,

Here you go. John Doll needs to sign the petition at some point and the petition decision needs to be mailed.

I backed up the examiner, but I wouldn't have done the election of species on the plant species. Seems unlikely that any additional search would be required. Also, they are right that, in plants, expressing the sense sequence can suppress gene expression as well as the antisense sequence (sometimes at least). So I might not have restricted on that basis, either. But they had not made that argument before, so I ignored it. I think my approach would have been different mainly because I am more familiar with the plant art (just guessing, don't really know Mary's background).

Obviously, we are only going to examine one sequence, though.

Sorry for the delay.

A handwritten signature in cursive script, appearing to read "Bruce". The signature is written in dark ink on a white background.